



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,714	08/17/2001	Dana Howard Jones	513612000200	6243
25224 7590 09/17/2008 MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024				
EXAMINER				
BOVEJA, NAMRATA				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
09/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/932,714

**Applicant(s)**

JONES, DANA HOWARD

**Examiner**

NAMRATA BOVEJA

**Art Unit**

3622

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.  
4a) Of the above claim(s) 2, 6-8, 12-16, 19-23 and 27-55 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 3-5, 9-11, 17, 18, 24-26 and 56 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notices of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to the RCE communication filed on 04/29/2008.
2. Claims 45-55 have been cancelled. Claim 56 has been added. Claims 1, 3-6, 9-11, 17, 18, 24-26, and 56 are presented for examination.
3. Amendments to claims 1, 3, 24, and 25 have been entered and considered.

#### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

4. Claim 1 is rejected under 35 U.S.C. 101, because, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method and system claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing, since the steps of selecting a sponsor message, offering an incentive, presenting a query, providing an incentive, and recording the presentation of the sponsor message in

*an activity log as recited in the claims can be performed mentally by a user.*

*Specifically, the claims do not recite these steps are performed using a computer.*

**Claim Rejections - 35 USC § 112**

*The following is a quotation of the first paragraph of 35 U.S.C. 112:*

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

5. *Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, there is no support for the limitation of media product in the specification submitted by the Applicant. According to the specification, only a product or a service is recited. Therefore, in light of the specification, media product is interpreted to mean product. Appropriate correction is required.*

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. *Claims 1, 3, 5, 6, 9-11, 17, 18, 24-26, and 56 are rejected under 103(a) as being anticipated by Kaplan (Patent Number 5,963,916 hereinafter Kaplan) in view of the*

*article titled, "Stores Lure Credit-Wary Consumers Retailers Employ Range Of Incentives To Draw Applicants," by Richard Foster published in the Richmond Times on November 27, 1993 on page C-1 (hereinafter Foster) and further in view of Davis et al. (Patent Number 6,269,361 hereinafter Davis).*

In reference to claim 1, Kaplan teaches a method for offering incentives related to purchase *transactions* of media products or services over a communications network, said method comprising the steps of: selecting a sponsor message to be associated with *a media product* or a service, said sponsor message being selected from a plurality of sponsor messages (i.e. selecting previews) (col. 2 lines 65 to col. 3 lines 16, col. 4 lines 20-40, col. 13 lines 10-18, and Figure 18); offering to a consumer the media product or service for sale, wherein said offer for sale is made to the consumer over a communications network (col. 17 lines 47-57, col. 18 lines 1-9, and Figures 53-55); offering to said consumer an incentive related to the purchase of said media product or service on the precondition that the consumer agrees to *first* receive or interact with a *sponsor message* (i.e. an incentive is offered is the consumer agrees to answer a question or even listen to a music sample) (col. 7 lines 14-24, col. 8 lines 45-51, and Figures 4, 19, and 20); *in response to receiving an acceptance of said offer from the consumer, presenting the selected sponsor message to the consumer over the communications network* (col. 7 lines 14-24, col. 8 lines 45-51, and Figures 4 and 18-20); and if the sponsor message is an interactive message, presenting at least one query to the consumer (col. 8 lines 45-51 and Figure 4); providing the offered incentive to the consumer (col. 7 lines 14-24).

*Kaplan is silent about a sponsor message including an advertisement by a sponsor, said advertisement being directed to a product or service by the sponsor other than the product or service associated with the sponsor message. Foster teaches a sponsor message including an advertisement by a sponsor, said advertisement being directed to a product or service by the sponsor other than the product or service associated with the sponsor message (i.e. a five minute instant credit card advertisement offering a 10% discount on the customer's purchases is presented to the customer, and this is advertisement for applying for a credit card is different than the actual products or services the user is purchasing at the retailer, Hecht's, on that day such as clothing, shoes, and accessories) (page 1 paragraphs 1 and 6, page 2 paragraphs 12, 13, and 23, and page 3 paragraph 25). It would have been obvious to modify Kaplan to include in a sponsor message an advertisement by a sponsor, said advertisement being directed to a product or service by the sponsor other than the product or service associated with the sponsor message to enable the customer to take advantage of a discount incentive on more than just item and to encourage the customer to purchase additional items.*

Kaplan is also silent about the method wherein said step of selecting includes verifying that the total number of times which the sponsor message has been previously presented is less than a number of predetermined transaction cycles contracted by the sponsor of the sponsor message; and recording the presentation of the sponsor message to an activity log, said step of recording including updating the number of times the sponsor message has been presented. Davis teaches the method wherein

said step of selecting includes verifying that the total number of times which the sponsor message has been previously presented is less than a number of predetermined transaction cycles contracted by the sponsor of the sponsor message (i.e. the advertisement listing will be suspended if the account is used up) (col. 13 lines 3-9 and col. 14 lines 1-8); *and* recording the *presentation of the sponsor message* to an activity log, said step of recording including updating the number of times the sponsor message has been presented (col. 13 lines 3-9 and col. 14 lines 1-8). It would have been obvious to modify Kaplan to include in the step of selecting verifying that the total number of times which the sponsor message has been previously presented is less than a number of predetermined transaction cycles contracted by the sponsor of the sponsor message; *and* recording the *presentation of the sponsor message* to an activity log, said step of recording including updating the number of times the sponsor message has been presented to enable the retailers to collect advertising revenue from the artists whose music consumers sample in the retail stores.

7. In reference to claim 3, Kaplan teaches the method, wherein said incentive includes a discount on the purchase of said media product *or service* (col. 7 lines 14-24).

8. In reference to claim 5, Kaplan teaches the method, wherein said incentive is providing the media product or service to the consumer free of charge (col. 7 lines 14-24).

9. In reference to claim 6, Kaplan teaches the method wherein said incentive includes providing information to said consumer (i.e. consumer is provided a printed

record of her preview screen) (col. 8 lines 45-48, col. 13 lines 66 to col. 14 lines 3, and Figure 20).

10. *In reference to claim 9, Kaplan teaches offering discounts for the purchase of products or services (col. 7 lines 14-24). Kaplan does not specifically teach the method, wherein said incentive includes in-store coupons for discounting purchase of products or services. Foster teaches the method, wherein said incentive includes in-store coupons for discounting purchase of products or services (i.e. \$5 Sears gift certificates) (page 2 paragraph 23 and page 3 paragraph 25). It would have been obvious to modify Kaplan to include among the incentives, in-store coupons for discounting purchase of products or services to enable the customer to have the flexibility of sharing the incentive with a friend or family member at a later time rather than having to use it on the immediate purchase.*

11. In reference to claim 10, Kaplan teaches the method, wherein said selected sponsor message is a multimedia presentation (col. 2 lines 65 to col. 3 lines 16, col. 4 lines 20-40, col. 13 lines 10-18, and Figure 18).

12. In reference to claim 11, Kaplan teaches the method, wherein said selected sponsor message is one of an interactive survey, an audio message, a visual display, and an Internet website (col. 2 lines 65 to col. 3 lines 16, col. 4 lines 20-40, col. 13 lines 10-18, and Figure 18).

13. In reference to claim 17, Kaplan teaches the method, further comprising the step of requesting said consumer to provide personal identification information (col. 7 lines 4-10 and Figure 56).



14. In reference to claim 18, Kaplan teaches the method wherein said identification information includes one of said consumer's e-mail address, address information, gender, and age (i.e. demographic information includes age etc) (col. 7 lines 4-10 and Figure 56).

15. In reference to claim 24, Kaplan teaches the method, further comprising the step of *providing the alternative option to the consumer of making payment to the content provider of the media product* (col. 18 lines 1-9 and Figures 54-57).

16. In reference to claim 25, Kaplan teaches the method, wherein said media product is downloadable from the Internet by the consumer (col. 4 lines 20-40 and 51-67, col. 10 lines 66 to col. 11 lines 20, and Figures 1-57).

17. In reference to claim 26, Kaplan teaches the method, wherein said communications network is one of the Internet, television cable network, telephone network, or satellite network (col. 4 lines 20-40 and 51-67, col. 10 lines 66 to col. 11 lines 20, and Figures 1-57).

18. *In reference to claim 56, Kaplan does not teach the method further comprising receiving a payment from the sponsor of the sponsor message presented to the user. Davis teaches the method further comprising receiving a payment from the sponsor of the sponsor message presented to the user (col. 13 lines 3-9 and col. 14 lines 1-8). It would have been obvious to modify Kaplan to include receiving a payment from the sponsor of the sponsor message presented to the user to enable the retailers to collect advertising revenue from the artists whose music consumers sample in the retail stores.*

19. Claim 4 is rejected under U.S.C. 103(a) as being unpatentable over Kaplan in view of Foster and further in view of Davis and further in view of the article titled, "Free Overnight Shipping From BravoGifts.com Just in Time For Administrative Professionals Day – This Wednesday, April 26<sup>th</sup>," published in the PR Newswire on April 24, 2000 on page 1 (hereinafter Bravo).

*In reference to claim 4, Kaplan does not teach the method, wherein said incentive includes paying for shipping and delivery charges related to the purchase of said product or service. Bravo teaches the method, wherein said incentive includes paying for shipping and delivery charges related to the purchase of said product or service (page 1 paragraphs 1-3). It would have been obvious to modify Kaplan to include among the incentives, paying for shipping and delivery charges related to the purchase of said product or service to encourage the user to make an online purchase and to give the user an option of not having to go to a brick and mortar store to buy a product or service.*

#### **Response to Arguments**

20. After careful review of Applicant's remarks/arguments filed on 04/29/2008, the Applicant's arguments with respect to claims 1, 3-6, 9-11, 17, 18, 24-26, and 56 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to claims 1, 3, 24, and 25 have been entered and considered.

21. Applicant's amendment successfully overcomes the previously made 35 U.S.C. 112 second paragraph rejection for claim 1.

22. A 35 U.S.C. 112 first paragraph rejection has been made for claim 1 due to a

lack of written description for the term media product in the Applicant's specification.

23. A 35 U.S.C. 101 rejection has been made for claim 1, since many of the steps are not tied to being performed by a computer as explained in the Office Action above.

24. Applicant argues that neither Kaplan nor Davis teach offering to a consumer an incentive related to the purchase of a media product or a service on the precondition that the consumer first agrees to receive or interact with a sponsor message. The Examiner respectfully disagrees and would like to point the Applicant to col. 7 lines 14-24, col. 8 lines 45-51, and Figures 4, 19, and 20, where Kaplan discloses offering incentives to a consumer when he agrees to answer a question or listen to a music sample and not offering the incentive if the consumer doesn't answer a question or listen to a music sample. However, Kaplan and Davis do not disclose the sponsor message to specifically include an advertisement as disclosed by the Applicant in the newly submitted claim amendments, and this new limitation has been addressed in the Office Action above using the Foster reference.

25. Applicant argues that the Examiner's interpretation of sponsor message to be inclusive of music preview selections is unreasonably broad. The Examiner respectfully disagrees with the Applicant. A sponsor message is what the terms says it is. It is a message by a sponsor. A message can be text, audio, a music preview, or even an advertisement. So, Examiner's interpretation of the term sponsor message is not broad. However, since the Applicant has amended the term to now state an advertisement in the newly amended claim, this new limitation has been addressed in the Office Action above using the Foster reference.

26. Applicant successfully challenged the Official Notices for claims 4 and 9, and references have been provided to address the Applicant's request. The Examiner has included the new references above in the claim rejections for claims 4 and 9 above that were necessitated by the amendment to independent claim 1 on which claims 4 and 9 depend.

27. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The Examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Application/Control Number: 09/932,714

Page 12

Art Unit: 3622

Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622